

REMARKS

Claims 1-7 are pending in the Application.

The Examiner again rejected claim 1 under 35 U.S.C. § 103 as being unpatentable over [U.S. Patent 5,880,769 to] Nemirofsky et al. (Nemirofsky 769) in view of U.S. Patent 5,380,991 to Valencia et al. (Office Action pages 2-4).

In Response to Arguments, the Examiner stated:

. . . the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. . .

Specifically, Nemirofsky et al discloses, “For example, instead of receiving light from a television display, the smart card may be optically coupled to a computer screen for receiving data over a computer network” [col 8, lines 20-24]. Thus, Nemirofsky et al suggests modifying the television display with that of a computer screen.

(Office Action page 2).

Applicant notes, however, that even if Nemirofsky 769 were modified as stated above, Nemirofsky 769’s data flow directions shown in Fig. 1 would remain the same, as discussed in more detail below.

Nemirofsky 769 discloses an Interactive smart card system for integrating the provision of remote and local services. Fig. 1 shows head end 15, television display 13, smart card 10, and remote service 16. A unidirectional line points from head end 15 to television display 13, a unidirectional line points from television display 13 to smart card 10, and a bi-directional line is between smart card 10 and remote service 16.

“In operation, the smart card receives information associated with a remote service provider from light emitted from the television display and receives input from a user.

Based upon the information received from the television and the user's input, the modem is provided with a telephone number to carry out an automated transaction with the remote service provider.” Nemirofsky 769 col. 1, line 63 – col.2, line 2. “the smart card 10 [] communicates with a remote service 16 over a two way communication medium such as a telephone line. The remote service 16 may comprise any type of service that supports digital communication and specific remote services will be described more fully below.” Nemirofsky 769 col. 2, lines 45-52.

“For example, the television display 13 may show a guided tour through a supermarket pointing out key nationally advertised items. Each of these items can be introduced and presented by a product spokesperson and followed with a commercial including a paperless coupon that may be provided to the user through the VEIL interface. For a description of the use of a smart card 10 in conjunction with coupons, see the related application entitled "COM-CARD", filed Jan. 19, 1994, Ser. No. 08/183/525. [now U.S. Patent 5,594,493¹]” Nemirofsky 769 col. 5, line 60 – col.6, line 2.

“The smart card 10 displays various menus on the LCD Screen 34 and a user of the smart card 10 may select menu options and provide other input to the smart card 10 through the buttons 30 and 32. Many other types of user interfaces are possible.” Nemirofsky 769 col. 3, lines 15-19.

1 U.S. Patent 5,594,493 to Nemirofsky (Nemirofsky 493) discloses, “While the TV Cardholder is watching television, the TV Card logo or icon is periodically displayed on the screen indicating that card-readable data is available. The consumer then presses the "TV" activate button 82 on the keypad 32 and holds the card, with a photoelectric television signal optical pickup device imbedded in it, facing and near the TV screen. Confirmation of good data reception is delineated to the TV Cardholder via characters displayed on LCD 42. The process described above uses photo and data detector 70 to decode light from the TV screen containing benefit or value data such as: money, discounts, value, redemption limits relating to individual stores or expiration

“According to the present invention, non-visual data encoded through VEIL protocol may be transmitted according to any type of packet protocol. . . . For example, the packet identification field may indicate that the data is related to coupons . . . ” Nemirofsky 769 col. 4, lines 2-16.

The Examiner stated that “Valencia et al discloses a paperless coupon redemption system and method that includes a smart card and the terminal device (including card reader/ writer) in communication with the card so as to write the data into the smart card and the POS read the smart card with the reader! writer (see Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Nemirofsky et al to include the method disclosed by Valencia et al.” (Office Action page 3).

In contrast, amended claim 1 recites, inter alia, a method of downloading a coupon for a product onto a smart card held by a user, the method comprising transmitting to the user computer by using an address associated with the user computer, via the global computer network, data referring to the product; receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product; responsive to the receiving step, transmitting to the user computer by using the address, via the global computer network, coupon data representative of the coupon; and writing the coupon data onto the smart card. No reasonable combination of the art of record suggests claim 1’s particular combination including the recited steps of transmitting, receiving, and

dates, Universal Product Codes (UPC) . . . ” Nemirofsky 493 col. 11, lines 29-42.

transmitting.

There seems to be no way to read claim 1 onto any reasonable modification of Nemirofsky 769. For example, if one attempts to read claim 1's "user computer" onto Nemirofsky 769's television display 13 (Fig. 1), the step of receiving cannot be satisfied. If one attempts to read claim 1's "user computer" onto Nemirofsky 769's smart card 10, the step of transmitting to the user computer, responsive to the receiving step, cannot be satisfied.

The Examiner rejected claims 2-4 under § 103 as being unpatentable over Nemirofsky 769 in view of U.S. Patent 5,710,886 to Christensen et al. and Valencia et al. (Office Action pages 4-5). The Examiner stated:

Christensen et al discloses transmitting to coupon data to a user computer, via a global computer network [col 8, lines 42-col 9, lines 8; see fig, 10-13]; reading the coupon data; determining if a list of products includes data corresponding to the coupon data; and reporting the coupon information to a clearinghouse [col 15, lines 20-col 16, lines 26].

In contrast, each of amended claims 2-4 recites, inter alia, a method of downloading a coupon for a product onto a smart card held by a user, the method comprising transmitting to the user computer, via the global computer network; receiving from the user computer, via the global computer network; responsive to the receiving step, transmitting to the user computer, via the global computer network; and writing the coupon data onto the smart card. No reasonable combination of the art of record suggests any of the respective combinations of claims 2, 3, or 4, including the recited steps of transmitting, receiving, and transmitting.

The Examiner rejected claims 5 and 7 under § 103 as being unpatentable over Christensen et al. in view of Nemirofsky 769 and Valencia et al. (Office Action pages 5-8).

In contrast, amended claim 5 recites, inter alia, a method including viewing a plurality of available downloadable coupons received via the global computer network on the computer monitor; generating an input to the computer indicating a selection of a selected coupon from the plurality of available downloadable coupons; receiving data corresponding to the selected coupon, the received data having been transmitted through the global computer network after step (b), and causing the received data to be written to the smart card.

Amended claim 7 is patentable as it recites, inter alia, a system comprising a program that receives a user selection, sends the received selection through the global computer network, receives coupon data corresponding to the selection, the received coupon data having been transmitted through the global computer network after the program sends the corresponding selection through the global computer network; and causes the processor to write coupon data that is received via the global computer network onto a smart card via the first smart card reader/writer.


The Examiner rejected claim 6 under § 103 as being unpatentable over Valencia et al. in view of Nemirofsky 769 (Office Action pages 8-9).

In contrast, amended claim 6 recites, inter alia, an electronic coupon downloading apparatus, comprising: a program that receives a user selection, sends the received selection through the global computer network, receives coupon data

corresponding to the selection, the received coupon data having been transmitted through the global computer network after the program sends the corresponding selection through the global computer network; and causes the processor to write coupon data that is received via the global computer network onto a smart card via the smart card reader/writer circuit

If the Examiner has any questions about this amendment, applicant's representative would appreciate discussing this amendment with the Examiner. Applicant's representative, Jerome Jackson, can be reached at 703-684-4840.

Respectfully submitted,


Jerome D. Jackson
Reg. No. 33,186

Jackson Patent Law Office
211 N. Union Street, Suite 100
Alexandria, Virginia 22314

Telephone 703-684-4840
Facsimile 703-995-0318

DATED: *26 March 2007*